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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,398	11/10/2003	Shutsung Liao	10634-002002 / UCHI 751	4394
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FISH & RICHARDSON PC				
P.O. BOX 1022				
MINNEAPOLIS, MN 55440-1022				
EXAMINER				
BADIO, BARBARA P				
ART UNIT			PAPER NUMBER	
1617				

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/705,398

Applicant(s)

LIAO ET AL.

Examiner

Barbara P. Badio, Ph.D.

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18,20-23,29,31-34,65 and 66 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18,20-22,29,31,32 and 65 is/are rejected.
- 7) ☒ Claim(s) 34 and 66 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**Final Office Action on the Merits**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Status of the Application***

2. Claims 18, 20-23, 29, 31-34, 65 and 66 are pending in the present application. Claims 23 and 33 stand withdrawn from further consideration as being drawn to a nonelected species. Claims 18, 20-22, 29, 31, 32, 34, 65 and 66 will be examined according to MPEP § 803.02.

***Claim Rejections - 35 USC § 102***

3. The rejection of claims 34 and 66 under 35 USC 102(b) over Kurosawa et al. is withdrawn.
4. The rejection of claims 18, 20-22, 29, 31, 32 and 65 under 35 USC 102(b) over Kurosawa et al. is maintained.

Applicant argues the reference does not anticipate the instant claims because claims 18 and 65 exclude carboxyl as a permissible substituent for Z when it is an alkenyl moiety. Applicant's argument is centered on compound 3b of the reference. Applicant's argument was considered but not persuasive for the following reason.

The rejection is based on the teaching of several bile acid derivatives.  $3\alpha,6\alpha$ -dihydroxy- $5\beta$ -cholest-24-en-26-oic acid is one of said bile acid derivatives. Kurosawa also teaches  $3\alpha,6\alpha$ -dihydroxy- $5\beta$ -cholestan-26-oic acid and  $3\alpha,6\alpha$ -dihydroxy- $5\beta$ -cholestan-24-oic acid (see for example, compounds 1a-11a and 1d-11d). It is noted that the instant claims encompass compounds wherein Z is alkyl substituted with carboxyl.

For this reason and those given in the previous Office Action, the rejection of claims 18, 20-22, 29, 31, 32 and 65 under 35 USC 102(b) over Kurosawa et al. is maintained.

**5. The rejection of claims 18, 20-22, 29, 31, 32 and 65 under 35 USC 102(b) over Kaiser (US 4,351,767) is withdrawn.**

6. Claims 18, 20-22, 29, 31, 32 and 65 are rejected under 35 USC 102(b) over Cohen-Solal.

Cohen-Solal et al. teaches hyodeoxycholic acid and  $\alpha$ -hyocholic acid and their effects on cholesterol and bile acid metabolism (see the entire article, especially Abstract). The compounds and compositions taught by the reference are encompassed by the instant claims.

### ***Claim Objections***

7. Claims 34 and 66 are objected to as being dependent upon a rejected base claim.

Note: The claims are allowable to the extent they read on the elected species, i.e., compound 30.

### ***Other Matters***

8. Applicant's request that claims 23 and 33 be rejoined and examined with the remaining pending claims is noted. However, the examiner notes that R<sup>10</sup>, R<sup>13</sup> and/or R' as defined by the elected species are not encompassed by claims 23 and/or 33.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

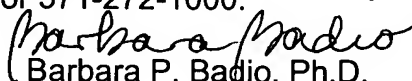
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Telephone Inquiry***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Barbara P. Badio, Ph.D.  
Primary Examiner  
Art Unit 1617

BB  
July 6, 2006